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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,690	12/04/2001	Richard Wojdyla	5384/55373	9872
7590 07/28/2004 KEITH E. GEORGE, ESQ. McDERMOTT, WILL & EMERY 600 13th STREET N.W. WASHINGTON, DC 20005-3096			EXAMINER LE, UYEN CHAU N	
			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,690

Applicant(s)

WOJDYLA ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 05 March 2004 and the Supplemental Amendment filed 23 April 2004.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-4, 9-10, 12-13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al (US 6,073,125) in view of Pickering Jr. et al (US 6,557,755).

Re claims 1-4, 9-10, 12-13 and 16: Cordery et al discloses a method for providing traceability of mail pieces, comprising the steps of: creating a plurality of mail pieces 104; providing a

first identification code on each of the plurality of mail pieces 104 (col. 3, lines 28+); creating a mailing statement 106 for the plurality of mail pieces 104 (fig. 1; col. 3, lines 50+); providing a second identification code on the mailing statement 106 (col. 3, lines 32+); and submitting the plurality of mail pieces to a postal service facility (col. 4, lines 52+); wherein the first identification code is encrypted (col. 3, lines 28+); wherein the step providing first identification code on each of the plurality of mail pieces 104 includes the step of passing each of the plurality of mail pieces through identification code producing equipment (fig. 2; col. 2, lines 40+); wherein the first identification code is independent from a meter imprint (i.e., the first identification code is encrypted); various mail pieces are delivered to a carrier acceptance unit 116 along with statements of the mailing, which can be in hard copy form or electronic form, where the first identification code on each of the mail pieces and the second identification code on the statements of mailing are verified via an acceptance unit scanner (col. 4, lines 1-31).

Cordery et al further teaches that the first identification code and the second identification code are generated by the mailer, and the mailer then signs the statement of mailing data; a printed statement includes a mailer identification number 306 and a mailer account 310 (fig. 3; col. 5, lines 7+). However, Cordery et al fails to teach or fairly suggest that the first identification code corresponding to a source of the mail pieces and the second identification code corresponding to the source of the mail pieces.

Pickering Jr. et al teaches the first identification code 202 corresponding to a source of the mail pieces; a number of records have been created during processing for updating a current status of each mailpiece, which serves as a statement of mailing, including a barcode origin, which serves as the second identification code (table 1, col. 6, lines 47+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the first identification code and the second identification code corresponding to a source of the mail pieces as taught by Pickering Jr. et al into the system of Cordery et al in order to provide Cordery et al with a capability of identifying the mailer readily. Furthermore, such modification would have been an obvious extension as taught by Cordery et al, and therefore an obvious expedient.

5. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al as modified by Pickering Jr. et al as applied to claim 1 above, and further in view of Leon (US 20030028497). The teachings of Cordery et al as modified by Pickering Jr. et al have been discussed above.

Re claims 5 and 14, Cordery et al/Pickering Jr. et al have been discussed above but fail to teach or fairly suggest that the first identification code is watermark.

Leon teaches a barcode 418 is watermark (fig. 4; page 1, paragraph [0021]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a watermark barcode as taught by Leon into the teachings of Cordery et al/Pickering Jr. et al in order to provide Cordery et al/Pickering Jr. et al with a more secure system, preventing the code from being manipulated by a mailer or an unauthorized operator.

6. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al as modified by Pickering Jr. et al as applied to claim 1 above, and further in view of Parkos (US 5,912,682). The teachings of Cordery et al as modified by Pickering Jr. et al have been discussed above.

Re claims 6 and 14, Cordery et al/Pickering Jr. et al have been discussed above but fail to teach or suggest that the first identification code is embedded into paper fibers.

Parkos teaches postage indicia 10' is embedded into paper fibers (fig. 2; col. 2, lines 41-58).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the use of paper fibers as taught by Parkos into the teachings of Cordery et al/Pickering Jr. et al in order to provide Cordery et al/Pickering Jr. et al with a capability of protecting the code/indicia from being damaged during handling or transporting and sorting the mails, and thus providing a more accurate system.

7. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al as modified by Pickering Jr. et al as applied to claim 1 above, and further in view of Benson (US 5,929,415). The teachings of Cordery et al/Pickering Jr. et al have been discussed above.

Re claims 7 and 14, Cordery et al/Pickering Jr. et al have been discussed above but fail to teach or fairly suggest that the first identification code is invisible.

Benson teaches a barcode 31 is invisible (fig. 1; col. 3, lines 20+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate an invisible barcode as taught by Benson into the teachings of Cordery et al/Pickering Jr. et al in order to provide Cordery et al/Pickering Jr. et al with a more secure system, preventing the code from being manipulated by a mailer or an unauthorized operator.

8. Claims 8, 11, 15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al as modified by Pickering Jr. et al as applied to claim 1 above, and further in view of Pintsov (US 6,009,416). The teachings of Cordery et al/Pickering Jr. et al have been discussed above.

Re claims 8, 11, 15 and 17-20: Cordery et al/Pickering Jr. et al have been discussed above but fail to teach or suggest the step of capturing and recording the identity of an individual

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submitting the plurality of mail pieces; the step of providing an alert indication when the first identification code does not correspond to the second identification code.

Pintsov teaches that a mailer's identity being recorded (e.g., name, address, telephone, internal account, banking or financial account, etc.) (fig. 4; col. 10, lines 14+); a suitable investigation can be implemented when information obtained from a scanned mail piece does not match with the correspond statement of mailing (col. 11, lines 24+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the step of capturing and recording the signature/identity of the sender as taught by Pintsov into the teachings of Cordery et al/Pickering Jr. et al in order to provide Cordery et al/Pickering Jr. et al with a more secure system wherein the identity of the sender can be identified/retrieved readily. Furthermore, such modification would provide Cordery et al/Pickering Jr. et al with a more accurate system wherein any suspicious mails can be notified, stopped and/or investigated immediately.

Response to Arguments

9. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited references to Cordery et al and Pickering Jr. et al were used in the new ground of rejection to further meet the limitation of claims 1 and 8.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Petkovsek (US 6,400,829); Sansone et al (US 4,947,333) are cited as of interest and illustrate a similar structure to a method and system for mailing security and traceability.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon, Wed. and Fri. 5:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le
July 25, 2004